

## REMARKS

Applicants respectfully request consideration of the subject application as amended herein. This Amendment is submitted in response to the Office Action mailed November 16, 2005. Claims 32-36, 38, 44 and 45 are rejected.

The Examiner has rejected claims 32-36, 38, 44 and 45 under 35 U.S.C. §103(a) as being unpatentable over Buist (USPN 6,408,282, "Buist") in view of Ferstenberg, et al. (USPN 5,873,071, "Ferstenberg").

Applicants respectfully submit that Buist and Ferstenberg, either individually or in combination, do not teach or suggest each and every limitation of claim 32.

With respect to claim 32, the Examiner states:

Buist does not disclose an indication of an acceptable negotiation and sending a message requesting the final offer but Ferstenberg discloses receiving an indication of an acceptable negotiation associated with the second active negotiation, the indication of an acceptable negotiation indicating that the third party has one last chance to submit a final multi-attribute offer (col. 23, lines 14-23); and sending a message to the third party requesting the final multi-attribute offer (cols. 13-14, line 58 to line 6).

(Office Action dated 11/16/05, p. 4)

Ferstenberg discloses:

This invention is adaptable to other rules for intermediary offer generation that have properties of (i) generating ultimately non-increasing offers for a commodity while (ii) not being merely limited to the amounts in the e-agents' counter-offers. In particular, the variable demands determined by the intermediary can depend on several prior intermediary offers and several prior e-agent counter-offers. Further, the demands can be chosen to be greater than the least of a determined number of prior counter-offers but less than the maximum of another determined number of prior offers.

(Ferstenberg, co. 23, lines 14-23).

In the following detailed description, an "offer" for a commodity is an electronic message sent from an intermediary to an e-agent that includes the amount of the commodity that the intermediary has made available to the e-agent to buy or sell

at a given stage of the electronic negotiation. A "counter-offer" for a commodity is an electronic message sent from the e-agent to the intermediary that includes the amount of the commodity that the e-agent intends to buy or sell at this stage of the electronic negotiation. An "opening" for a commodity is an initial electronic message sent from an e-agent to the intermediary that includes the maximum amount of a commodity that the e-agent intends to buy or sell in a given negotiation. Preferably, offers, counter-offers, and openings contain data for all the commodities to be exchanged in one electronic message.

(Ferstenberg, cols. 13-14, line 58 to line 6).

Outside the cited text, Ferstenberg discloses exchanging messages to facilitate an intermediated exchange of financial commodities between participants called "e-agents".

(Ferstenberg, Abstract). Ferstenberg discloses:

At step 14, the negotiation successfully terminates if all the e-agents signal that they are satisfied with their last offers from the intermediary. Preferably, they do this by returning counter-offers that are equal to the previous offers. Alternatively, the negotiation can be terminated after a predetermined number of steps of negotiation, whether or not all the e-agents signal satisfaction.... If the negotiation did not terminate at step 14, then at step 15, the intermediary generates new offers by a process similar to that for generating initial offers ... based on the immediately preceding counter-offer and the immediately preceding offer.

(Ferstenberg, col 19, lines 32-54).

Thus, Ferstenberg discloses generating ultimately non-increasing offers for a commodity, such that a negotiation terminates with a signal of satisfaction by e-agents and does not teach or suggest an indication that the third party has one last chance to submit a final multi-attribute offer. Further, Ferstenberg discloses only that offers and counter-offers for a commodity are made, and is silent about and therefore, does not teach or suggest sending a message to the third party requesting the final multi-attribute offer, as claimed.

Applicants respectfully argues that Ferstenberg does not teach or suggest claim elements missing from Buist, and therefore the combination of Buist and Ferstenberg fails to establish a *prima facie* case for obviousness. Further, in addition to maintaining that the Examiner's

combination does not teach or suggest all elements in Applicants' claims, Applicants respectfully submit that the Examiner has not demonstrated the motivation required to combine Buist's disclosure with that of Ferstenberg. The Examiner states that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the indication of acceptable negotiation and the message requesting the offer as taught by Ferstenberg into the system of Buist because it would provide e-agent programs that generate counter-offer messages representing acceptance of the total amounts of commodities offered in the immediately preceding offer messages received from the intermediary program." (Office Action dated 11/16/05, p. 4).

The Examiner appears to have merely taken a desired end result, as recited in Applicant's claims, and stated that a combination of Buist and Ferstenberg achieves this end result. Such a position is impermissible hindsight based on applicants' own disclosure. Applicant respectfully requests the Examiner point to the required intrinsic or extrinsic motivation within the references themselves, or within knowledge of persons of ordinary skill in the art at the time of the invention, to form such a combination.

Thus, applicants respectfully submit that independent claim 32 and associated dependent claims 33-36, 38, 44 and 45 are not obvious over the combination of Buist and Ferstenberg.

The Examiner has also rejected claims 32-36, 38, 44 and 45 under 35 U.S.C. §103(a) as being unpatentable over Bigus, et al. (USPN 6,085,178, "Bigus") and Ferstenberg.

Applicants respectfully submit that Bigus and Ferstenberg, either individually or in combination, do not teach or suggest each and every limitation of claim 32.

With respect to claim 32, the Examiner states:

Bigus does not disclose an indication of an acceptable negotiation and sending a message requesting the final offer but Ferstenberg discloses receiving an

indication of an acceptable negotiation associated with the second active negotiation, the indication of an acceptable negotiation indicating that the third party has one last chance to submit a final multi-attribute offer (col. 23, lines 14-23); and sending a message to the third party requesting the final multi-attribute offer (cols. 13-14, line 58 to line 6).

(Office Action dated 11/16/05, p. 7)

As discussed above, Ferstenberg does not teach or suggest an indication that the third party has one last chance to submit a final multi-attribute offer, and sending a message to the third party requesting the final multi-attribute offer, as claimed.

Applicants respectfully argues that Ferstenberg does not teach or suggest claim elements missing from Bigus, and therefore the combination of Bigus and Ferstenberg fails to establish a *prima facie* case for obviousness. Further, in addition to maintaining that the Examiner's combination does not teach or suggest all elements in applicants' claims, applicants respectfully submit that the Examiner has not demonstrated the motivation required to combine Bigus's disclosure with that of Ferstenberg. The Examiner states that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the indication of acceptable negotiation and the message requesting the offer as taught by Ferstenberg into the system of Bigus because it would provide e-agent programs that generate counter-offer messages representing acceptance of the total amounts of commodities offered in the immediately preceding offer messages received from the intermediary program." (Office Action dated 11/16/05, pages 7-8).

The Examiner appears to have merely taken a desired end result, as recited in Applicant's claims, and stated that a combination of Bigus and Ferstenberg achieves this end result. Such a position is impermissible hindsight based on applicants' own disclosure. Applicant respectfully requests the Examiner point to the required intrinsic or extrinsic motivation within the references

themselves, or within knowledge of persons of ordinary skill in the art at the time of the invention, to form such a combination.

Thus, Applicants respectfully submit that independent claim 32 and associated dependent claims 33-36, 38, 44 and 45 are not obvious over Bigus and Ferstenberg.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Lester Vincent at (408) 720-8300.

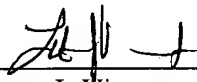
**Deposit Account Authorization**

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR  
& ZAFMAN LLP

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